

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AEW, Inc.

Serial No. 74/447,347

John K. Donaghy, Esq., attorney for applicant.

Peter Cataldo, Trademark Examining Attorney, Law Office 103
(Michael Szoke, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

AEW, Inc. has filed a service mark application to
register on the Principal Register the mark shown below for
"retail auto parts stores."¹

¹ Serial No. 74/447,347, in International Class 42, filed October 15, 1993, based on use of the mark in commerce, alleging dates of first use as of June 20, 1961, and first use in commerce as of June 3, 1963. This is an application to register as a concurrent user. Should the issues on appeal herein be determined ultimately in favor of applicant, the concurrent use issue will be addressed following the close of the opposition period, if no oppositions are filed, or following the dismissal of any oppositions that may be filed. See, Trademark Rule 2.99, 37 CFR 2.99. The application also includes the seemingly inconsistent statements "the lining in the drawing is a feature of the mark" and "the color blue is intended by the lining." Should the issues on appeal herein be determined ultimately in favor of applicant,

The Trademark Examining Attorney initially required, under Section 6 of the Trademark Act, 15 U.S.C. 1056, a disclaimer of DISCOUNT AUTO PARTS STORES apart from the mark as a whole on the ground, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), that this portion of applicant's mark is merely descriptive in connection with its services. Subsequently, applicant claimed that the DISCOUNT AUTO PARTS STORES portion of its applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f). In support of its claim, applicant submitted the declaration of David Burmeister, comptroller of applicant, attesting to advertising and promotional expenditures in connection with the mark. Additionally, applicant submitted samples of its advertising materials.

The Trademark Examining Attorney has finally required a disclaimer of the DISCOUNT AUTO PARTS STORES portion of applicant's applied-for mark, under Section 6 of the

this inconsistency should be resolved in order for this application to be otherwise in condition for publication.

Trademark Act, 15 U.S.C. 1056, on the ground, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), that this portion of applicant's mark, when used in connection with retail auto parts store services, is generic and, thus, incapable of a source-identifying function as part of the applied-for mark. The Examining Attorney rejected applicant's Section 2(f) claim of acquired distinctiveness, and evidence in support thereof, on the ground that because DISCOUNT AUTO PARTS STORES is generic, no amount of evidence is sufficient to establish acquired distinctiveness thereof. Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issues before us are whether the DISCOUNT AUTO PARTS STORES portion of applicant's mark, when used in connection with retail auto parts store services, is generic,² or, if not generic, whether, under Section 2(f), the DISCOUNT AUTO PARTS STORES portion of applicant's mark has acquired distinctiveness.³

² If generic, this portion of applicant's mark is considered incapable of indicating source and cannot attain trademark significance. See, *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

³ Because applicant amended its application to assert a claim of acquired distinctiveness, under Section 2(f), in relation to the DISCOUNT AUTO PARTS STORES portion of its mark, applicant has conceded this portion of the mark to be merely descriptive. Thus, if not generic, the only question is whether it is registrable on the basis of

Genericness

We turn, first, to the issue of genericness. The Examining Attorney contends that the identification of services and the evidence made of record by applicant clearly establish that "applicant's retail stores make available auto parts at a discount [and] [i]t is difficult to imagine a more succinct expression to describe such services than 'discount auto parts stores.'" In other words, the Examining Attorney states that "discount auto parts stores" identifies the central characteristic of applicant's services. The Examining Attorney contends, further, that excerpts in the record of articles from the LEXIS/NEXIS database "demonstrate that in the auto parts business, the term 'discount auto parts stores' is used as the commonly accepted term to identify stores that sell auto parts at a discount [and that] the term 'discount auto parts stores' is recognized by the relevant consuming public to be a generic term as applied to such stores" The following are several examples of these excerpts from the LEXIS/NEXIS database:

"I bought ... at discount auto parts stores - and a buck or so more at hardware stores." *Chicago Tribune*, May 10, 1992.

acquired distinctiveness. See, *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994).

Trak Auto Corp., which operates more than 100 discount auto parts stores in the Los Angeles area ..." *The Washington Times*, May 6, 1992.

"... E.P.B. had done the oil change, lube and service himself, and even if he had bought everything he needed at a discount auto-parts store, it would have cost him about \$38.95." *Newsday*, January 15, 1994.

"ADAP operates about 70 discount auto parts stores in the Northeast and employs about 800 people system-wide." *The Boston Globe*, September 30, 1988.

The Examining Attorney also submitted several third party registrations of marks containing, respectively, the disclaimed terms "discount auto stores," "discount auto parts," "auto parts," and "auto parts stores" for auto parts, auto parts stores and related services.⁴

Applicant states, in its brief, that, since 1963 it has used the names "Discount Auto Parts Stores" and "DAPS Discount Auto Parts Stores" in connection with its chain of fourteen auto parts stores; that DAPS is an acronym for "Discount Auto Parts Stores"; that the mark is prominently displayed on its store fronts; and that it "has expended large sums of money in advertising the trade names 'Discount Auto Parts Stores' and its acronym 'DAPS,' and in acquainting the members of the public with the services and

⁴ We have not considered these registrations as evidence of use of the registered marks.

business presently owned by the Applicant." Applicant contends the following:

The terms "Discount," "Auto," "Parts" are each descriptive of the characteristics or qualities of Applicant's goods or services. Even if one or more of the words "Discount," "Auto," "Parts" and "Stores" could be classified as generic when used alone, the terms as combined result in a combination of terms that is at most descriptive of Applicant's services and entitled to protection by virtue of the secondary meaning which Applicant's name or mark has acquired in the Marketing Area.

Applicant contends, further, that the Examining Attorney has not demonstrated that the term "discount auto parts stores" is the name of a class of services or that it would be so recognized by the relevant public; and that any doubt on the issue of genericness should be resolved in applicant's favor.

The critical issue in genericness cases is whether members of the relevant public principally use or understand the term sought to be registered to refer to the category or class of goods or services in question. *In re Recorded Books, Inc.*, 42 USPQ2d 1275 (TTAB 1997); and *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered

understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

The evidence submitted by both the Examining Attorney and applicant supports the conclusion that the principal category of services involved herein is auto parts stores; and that a sub-category of these services is auto parts stores offering auto parts at a discount. Certainly, applicant does not dispute the first part of our conclusion regarding the principal category of services, as applicant uses the phrase "auto parts stores" to identify its services in the application. We find that the record clearly supports the further conclusion that the composite phrase, "discount auto parts stores," is a recognized generic equivalent of the sub-category of auto parts stores offering auto parts at a discount.

Additionally, the evidence of record supports the conclusion that the relevant public, which here is the general purchasing public, primarily understands the

DISCOUNT AUTO PARTS STORES portion of the applied-for mark to refer to retail auto parts stores offering auto parts at a discount, rather than primarily viewing this designation as an indication of a single source of these services.

In making this determination, we have taken into consideration all evidence of record pertinent to the public perception of the designation, including any evidence submitted in connection with applicant's claim of acquired distinctiveness. *See, In re Recorded Books, Inc.*, *supra* at 1282; and *In re Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988). The evidence establishes that the relevant public will understand the phrase "discount auto parts stores" in its generic sense when considered in connection with applicant's identified services, notwithstanding applicant's contentions otherwise, the length of applicant's use of its mark, or its advertising in connection therewith. Contrary to applicant's contention, we find nothing incongruous in applicant's combination of these common generic terms in the applied-for mark when considered in connection with applicant's services. Applicant has done no more than combine generic terms that are individually applicable to its services. The combination creates no different commercial impression; the generic meaning is not lost. Thus, the composite

designation is likewise generic. *See, In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987).

Applicant has introduced no evidence which might contradict the conclusion that "discount auto parts stores" is a generic descriptor of the nature of applicant's services. In fact, applicant's own radio advertising submitted in connection with its claim of acquired distinctiveness demonstrates use of the phrase "discount auto parts stores" in a generic, rather than source identifying, manner. Excerpts from several transcripts of its radio advertisements follow:

RIGHT NOW DURING THE THIRD ANNIVERSARY AT DAPS YOUR ORIGINAL DISCOUNT AUTO PARTS STORE, STP SINGLE OIL FILTERS ARE AS LOW AS ... SO COME IN TODAY BECAUSE STP IS THE EDGE AT DAPS ... THE ORIGINAL DISCOUNT AUTO PARTS STORE ON RACETRACK ROAD [WMMK 92, 3/16/89.]

D.A.P.S. ON RACETRACK ROAD IS CELEBRATING THEIR 3RD ANNIVERSARY .. AND TO CELEBRATE, THEY'VE GOT SPECIALS THROUGHOUT THE STORE. ... D.A.P.S., THE ORIGINAL DISCOUNT AUTO PARTS STORE, RACETRACK ROAD. [WMMK 92, 2/22/89.]

... YOU WON'T FIND A PRICE THIS LOW ANYWHERE ELSE BUT DAPS BECAUSE DAPS IS DISCOUNT AUTO PARTS STORE [WWL 870 AM, 7/1/93.]

... DAPS IS THE PLACE TO GET STARTED. ... AND DAPS SALESPeOPLE KNOW THEIR STUFF AND SPEAK YOUR LANGUAGE. SO GET GOIN' AT YOUR LOCAL DAPS AUTO PARTS. [WKRg TV, 9/17/91.]

... GET A HOLLEY 'PERFORMANCE' CARBURETOR AT 'DAPS' AUTO PARTS ... THE ORIGINAL DISCOUNT AUTO PARTS STORES SINCE 1963. [WTKX FM, 12/19 - 29/94.]

Applicant appears to argue, simply, that its long use and evidence of acquired distinctiveness outweigh the evidence relied upon by the Examining Attorney in support of the genericness refusal. We have fully considered this evidence. However, when, as in this case, we have found that the evidence as a whole establishes that the matter in question is primarily perceived by the purchasing public as a generic reference, any de facto secondary meaning that the designation may have acquired cannot render the designation registrable. *See, In re Recorded Books, supra* at 1281, and the cases cited therein.

Applicant's evidence is insufficient to establish that the purchasing public views the phrase "discount auto parts stores" as an indication of source. Rather, the Examining Attorney has met his burden of proof by the introduction of clear evidence that the public perception of "discount auto parts stores" is as a generic descriptor for retail auto parts store services.

Accordingly, we find the DISCOUNT AUTO PARTS STORES portion of applicant's applied-for mark to be generic when considered in connection with the identified services. As

such, this phrase is incapable of identifying and distinguishing applicant's services from those of others.

Acquired Distinctiveness

In order to render a complete opinion, we address the question of whether the DISCOUNT AUTO PARTS STORES portion of applicant's mark, if ultimately determined not to be generic, has acquired distinctiveness. In this regard, we find that applicant's evidence under Section 2(f) is insufficient to establish that the relevant portion of its applied-for mark has acquired distinctiveness in connection with the identified services. Applicant has provided a declaration indicating applicant's general promotional efforts and advertising figures, along with several copies of newspaper advertisements and transcripts of radio advertisements. However, applicant has not provided any evidence specifically addressing the amount of sales in connection with the mark or the relevant portion herein. Nor has applicant provided any evidence in connection with consumer perception of the relevant portion of the mark. Applicant's evidence in connection with the extent of expenditures and promotion are indicative only of applicant's attempts to develop distinctiveness, rather than the achievement of the same. *See, e.g., In re Recorded Books, Inc., supra* at 1282.

In view of the highly descriptive nature of the phrase "discount auto parts stores," the evidence of record is insufficient to establish that the DISCOUNT AUTO PARTS STORES portion of the applied-for mark has acquired distinctiveness in connection with retail auto parts stores.

Decision: The requirement for a disclaimer of the DISCOUNT AUTO PARTS STORES portion of the mark herein on the ground that this phrase is generic in connection with the identified services is affirmed.

Alternatively, if the DISCOUNT AUTO PARTS STORES portion of the mark herein is not generic but is merely descriptive in connection with the identified services, the disclaimer requirement is affirmed inasmuch as applicant's claim under Section 2(f) is insufficient evidence of acquired distinctiveness thereof.

In accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Examining Attorney to place in condition for publication for opposition⁵ if applicant, no more than thirty days from the mailing date of this decision, submits an appropriate disclaimer of DISCOUNT AUTO PARTS STORES.

G. D. Hohein

C. E. Walters

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

⁵ Should applicant decide to comply with this requirement and this decision is set aside, prior to publication the Examining Attorney may wish to obtain from applicant a clarification of the lining and color statements as noted herein.